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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/845,879 | 04/30/2001 | Lee D. Whetsel | TI-31205 | 4748 |

23494 7590 02/27/2004

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| EXAMINER |
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CHUNG, PHUNG M

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| ART UNIT | PAPER NUMBER |
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2133

DATE MAILED: 02/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,879

Applicant(s)

WHETSEL, LEE D.

Examiner

Phung M. Chung

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite basis for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, line 1, "An integrated circuit comprising at least one dual mode test access port" is vague and indefinite because it claimed only one dual mode test access port. It also fails to show how to make and/or use of the invention.

2. Claims 1-16 are objected to because of the following informalities:

As per claims 1-6, line 2, 3 or 4, "comprising the steps of;" should be changed to --, comprising the steps of: --.

As per claims 7-11, line 1, a comma -- , -- should be inserted after "claim 6".

As per claims 12-16, line 1, "comprising;" should be changed to --, comprising: --.

Appropriate correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Whetsel (5,606,566).

As per claims 1, Whetsel discloses the invention substantially as claimed, comprising the steps of:

Communicating to test access ports within an integrated circuit using a first protocol compliant with IEEE 1149.1 to setup communication to the test access ports; and

Communicating to the test access port using a second protocol. (See col. 1, line 49 to col. 2, line 22).

As per claims 2 and 3, these claims are also rejected under the same rationale as set forth in claim 1.

As per claim 4, Whetsel discloses the invention as claimed, comprising the steps of:

Shifting an instruction into an instruction register of the test access port using 1149.1 protocol;

Updating the instruction from the instruction register using the 1149.1 protocol; and

Enabling, in response to the updating, the test access port to respond to another protocol. (Col. 9, lines 34-64).

As per claims 12-16, Whetsel discloses the invention substantially as claimed, comprising:

An integrated circuit, comprising: a set of data registers; and

A dual mode test access port for providing access to the set of data registers. (See col. 1, line 49 to col. 2, line 22, col. 3, lines 17-57 and col. 6, line 30-48).

As per claims 5-11, these methods claims are also rejected under the same rationale as set forth in the system claims 12-16.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung M. Chung whose telephone number is 703-305-9686. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PHUNG M. CHUNG
PRIMARY EXAMINER